

REMARKS

*Substantive
Remarks
only 12/1/03*
Introduction

In accordance with the foregoing, claim 2 has been amended. No new matter is being presented, and approval and entry are respectfully requested. Applicant respectfully submits that the amendment to claim 2 is minor, and does not affect the patentability of claim 2 or raise any new issues.

A first Rule 116 amendment was filed October 17, 2003, but as indicated in the Advisory Action mailed October 30, 2003, the amendment was not entered.

Further, in response to the Advisory Action, and in accordance with the telephone interview with the Examiner of November 17, 2003, Applicant respectfully submits that the phrase "...an elastic member made of one of rubber and resin..." in amended, independent claim 2 means an elastic member made of only one of the two enumerated items.

The above-mentioned phrase in amended, independent claim 2 contrasts with a phrase "...at least one of X and Y," which could mean one or both of the enumerated items.

Claims 2-5 are pending and under consideration.

Entry of Amendment Under 37 C.F.R. §1.116

Applicant requests entry of this Rule 116 Response because:

(a) the amendment of claim 2 should not entail any further search by the Examiner since no new features are being added and no new issues are being raised; and

(b) the amendment does not significantly alter the scope of this one claim, and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining

Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Rejections Under 35 U.S.C. §103

At page 2, item 3, of the Office Action, the Examiner rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over Moretti et al. (US 6,179,471). At page 3, item 5, of the Office Action, the Examiner rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Moretti et al. in view of Gomez (5,833,371).

Amended claim 2 recites "...a sealing member secured to the stationary bearing ring; ... wherein the sealing member includes a core metal fitted to the stationary bearing ring, and an elastic member made of one of rubber and resin and integrated together with the core metal and wherein the temperature sensor is secured to the core metal in contact therewith."

With respect to claim 2, at page 2, item 3, of the Office Action, the Examiner asserts that Moretti et al. teaches a sealing member that includes both a core metal 10 and a sealing device 9. Further, the Examiner asserts that Moretti et al. does not disclose that the sealing device 9 is made of rubber or resin. The Examiner then asserts that it would have been obvious to modify the sealing device 9 so that it is made of rubber or resin.

Applicant respectfully submits, however, that the Examiner is misconstruing the teachings of Moretti et al.. For example, Moretti et al., at col. 2, lines 12-19, states:

Reference numeral 9 designates overall in Fig. 1 a sealing device of conventional design for sealing the annular gap 20 between the outer race 1 and the inner half 2b from the axially outer side of the bearing. The sealing device 9 is comprised of an annular sealing insert 10 integral with the stationary outer race and an annular insert 11 fast for rotation with the axle 4 and the other rotating parts of the unit. (emphasis added)

As such, as shown in Fig. 1, the sealing device 9 includes the annular sealing insert 10, which is integral with the stationary race, and the annular insert 11, which rotates with the rotating axle 4. It appears that the Examiner's confusion with respect to these features has been caused by the fact that Moretti et al.'s Fig. 3 incorrectly refers to the rotating annular insert by reference number 9. The Examiner is respectfully invited to compare Moretti et al.'s reference numbers 9 and 11 in Fig. 1 and reference number 9 in Fig. 3.

Based on this error in Moretti et al., it is the Examiner's position that the annular insert 11 (identified by reference numeral 9 in Fig. 3) is a part of a sealing member that is "secured to the

stationary bearing ring." Instead, as is discussed in Moretti et al.'s passage above, the annular insert 11 instead rotates "with the axle 4 and the other rotating parts of the unit." Therefore, the annular insert 11 cannot correspond to the claimed "elastic member" because the annular insert 11 is not "secured to the stationary bearing ring."

Therefore, the only portion of the sealing member that is "secured to the stationary bearing ring" is the annular sealing insert 10. This annular sealing insert 10 is disclosed as being metallic or made of another rigid material (see Moretti et al. at col. 2, lines 19-21).

Consequently, Moretti et al.'s device for mounting a sensor to a railway bearing is deficient at least because the annular sealing insert 10 is only described as being metallic or made of another rigid material, and there is no teaching or suggestion of the additional feature of an "elastic member made of one of rubber and resin" that is "integrated together with the core metal" and is part of a sealing member that is "secured to the stationary bearing ring."

Applicant respectfully submits that claim 2 patentably distinguishes over the cited art, and should be allowable for at least the above-mentioned reasons. Further, applicant respectfully submits that, claim 5, which depends from independent claim 2, should be allowable for at least the same reasons as claim 2, as well as the additional features recited therein.

Additionally, at page 3, item 5, of the Office Action, the Examiner indicated that claims 3 and 4 would be allowable if rewritten in independent form. Applicant thus respectfully submits that claims 2-5 should be allowable.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP
ATTORNEYS FOR APPLICANT
USPTO Customer No. 21171

Serial No. 09/972,949

Date: 18 NOV 2003

By: Michael A. Bush
Michael A. Bush
Registration No. 48,893

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501